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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/735,119	12/11/2003	Stephen M. Dershem	QUANT1350-I (028248-2302)	1929
7590	11/10/2005		EXAMINER	
Steven C. Bauman HENKEL CORPORATION 1001 Trout Brook Crossing Legal Department Rocky Hill, CT 06067			SANDERS, KRIELLION ANTIONETTE	
			ART UNIT	PAPER NUMBER
			1714	
DATE MAILED: 11/10/2005				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/735,119

Applicant(s)

DERSHEM ET AL.

Examiner

Kriellion A. Sanders

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 36-48 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 36-48 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 4/04.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: ____.

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claim 36 is rejected under 35 U.S.C. 102(b or e), as being clearly anticipated by Ishida et al, US Patent No. 6207786.

3. Applicant's claims encompass any benzoxazine in liquid form. This subject matter differs from that of parent application 10/008,591, which limited the structure of the benzoxazine. Therefor the present invention appears to be entitled to the benefit of only the filing date of 12/11/03.

4. The patented disclosure teaches an adhesive comprising a benzoxazine in liquid form. The epoxy into which the benzoxazine is mixed is liquid and thermosetting. A cure initiator is also used. See col. 7, line 28 through col. col. 8, line 19 and claims 1-16.

5. Claim 36 is rejected under 35 U.S.C. 102(e), as being clearly anticipated by Davis et al, US Patent No. 6906120.

6. Applicant's benzoxazine thermosetting resin and curing agent are set forth therein. See claim 1.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 36-47 are rejected under 35 U.S.C. 103(a) as being unpatentable over Davis et al, US Patent No. 6906120.

9. Davis discloses a composition of benzoxazine, polyarylene ether, curing agent and optional adjuvants as well as the use of the composition as an adhesive for metal substrates including copper. Applicant's claimed method is considered obvious over the disclosure of the reference, which suggests each parameter of applicant's process steps. The ordinary practitioner would be advised as to which substrates are electrically or thermally conductive, particularly in the manufacture of circuit boards or other electronic parts. Davis discloses circuit boards. See col. 9, line 43 through col. 11, line 5.

10. Claims 36-48 are rejected under 35 U.S.C. 103(a) as being unpatentable over Davis et al, US Patent No. 6906120 as applied to claims 36-47 and further in view of Dershem et al., US Patent Nos. 6034194 or 6034195.

Davis et al. recognizes that polyimide resins may be used in the compositions of the patented invention. See col. 11, line 39 through col. 12, line 55. Dershem et al. indicates specifically that maleimides of the disclosed formulae are suitable for making adhesive compositions with high flexibility and low moisture uptake. It would have been obvious to one

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of ordinary skill in the art to employ the maleimides of Dersham et al. '194 or '195 as those polyimides suggested by Davis et al. for formulating adhesive compositions.

Information Disclosure Statement

References cited in an IDS must include a month and year of publication to be considered.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kriellion A. Sanders whose telephone number is 571-272-1122. The examiner can normally be reached on Monday through Thursday 6:30-7:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan can be reached on 571-272-1119. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Kriellion A. Sanders
Primary Examiner
Art Unit 1714